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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,195	06/05/2001	James E. Christensen	YOR920010213US1	6833

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EXAMINER
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KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/874,195

Applicant(s)

CHRISTENSEN ET AL.

Examiner

James A. Kramer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the scope of the limitation “said business condition being extrinsic to said list of items” in independent claims 1, 15 and 26 is unclear. Applicant’s specification fails to clearly define the scope of this limitation; in fact Applicant’s specification is completely silent on extrinsic business conditions.

Instead, Applicant attempts to introduce the term “extrinsic” in the argument of paper 5, by way of examples. Applicant asserts that all the conditions taught by Junger are intrinsic and whereas the conditions of Applicant’s invention on extrinsic. Unfortunately this does not correspond to the definition of extrinsic.

Webster’s defines extrinsic as external or coming from the outside. As such, Examiner agrees that the following conditions would be intrinsic to an item to be returned: packaging missing, major component missing, and item not returnable as part of the condition of sale, as all of these condition related directly to the item.

In contrast Examiner believes that the warranty period expiring, is extrinsic, as this condition relates not to the product itself but to the warranty, which is external (definition of extrinsic) to the item.

In summary, claims 1-35 stand rejected under 35 U.S.C. 112 second paragraph, because applicant has failed to particularly point out and distinctly claim the scope of an extrinsic business condition.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-34, as interpreted by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 6,085,172 to Junger (hereinafter Junger).

Junger teaches a method and apparatus for product return transactions that includes a return approval computer system utilizes product identifying information to determine whether a returned product satisfies applicable return criteria (column 2; lines 47-49). Junger further teaches a return approval location providing a list of approved returns and unapproved returns along with a return authorization or confirmation (column 2; lines 54-56). Junger teaches input devices and computing devices connected via the Internet (column 5; lines 9-12).

Junger teaches return criteria that includes temporal, usage or a dynamic rule that a business value condition must be satisfied (column 7; lines 7-14). Junger further teaches determining if one of the items needs to be physically returned and if not saving the cost of shipping by not returning the product (column 7; lines 13-17).

Junger teaches a data storage unit that stores data associated with the purchased items. In particular data is saved in regards to product identification, purchase location, date of return and quantity purchased. Junger teaches not only having this data available for mining but also mining the data in order to determine if a proper return is being made (column 6; lines 47-57).

Examiner notes the Junger teaches a business condition related to the warranty period, as explained in the rejection under USC 112 second paragraph, this is interpreted as an extrinsic business condition, as it does not relate to the item directly.

***Claim Rejections - 35 USC § 103***

Claim 35 as interpreted by the Examiner is rejected under 35 U.S.C. 103(a) as being unpatentable over Junger in view of Williams et al.

Junger, as described in detail above does not specifically teach said business condition is at least one condition selected from the group consisting of: a purchase and return history of said customer, a value of continued business with said customer, a small number of returns from said customer, and any combination thereof.

Williams et al. teaches an apparatus, system and method for online, multi-parcel, multi-carrier, multi-service parcel returns shipping management. Examiner specifically references pages 12-13; paragraph 210 and Figure 15. Williams et al. teaches a return policy which includes customer exceptions for top-tier customers that deserve special treatment (a value of continued business with said customer).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Junger to include a business decision that allows exceptions for top-tier customers as taught by Williams et al. One of ordinary skill in the art at the time of the invention would be motivated to combine the reference in order to give special treatment to valued customers, as taught by Williams et al.

***Response to Arguments***

Applicant's arguments filed 12/3/03 have been fully considered but they are not persuasive. Applicant asserts that Junger does not teach extrinsic business conditions. Examiner disagrees for the reasons set forth in the rejection under USC 112 second paragraph, above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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